

## DISCUSSION

### The Section 112, Second Paragraph Rejection

Applicants respectfully submit that the Claims, as currently amended, particularly point out and claim the subject matter which applicants consider to be their invention. Specifically, Claims 16, 28 and 30 have been amended to address the issues raised by the Examiner and Applicants believe the Section 112, 2<sup>nd</sup> paragraph rejection has been overcome and rendered moot.

### The Claims 16, 18-25 and 28 Section 103(a) Rejection

As indicated the Examiner has rejected Claims 16, 18-25 and 28 under Section 103(a) over *Bailey et al.*, in view of *Crane*. The Examiner has stated that *Bailey, et al.*, teaches a bookmark having a flexible, elastic intermediate member or ribbon C having opposed ends. Hooks (anchors) c are attached to each of the ends.

Applicants respectfully disagree with the Examiner's characterization of *Bailey, et al.*, as a bookmark. As described in the specification and as claimed by Applicants, the bookmark of the subject invention is a device to mark one's place within a book, wherein an elongated, substantially flat member is placed between the pages of a book to mark the page the reader was on. Abutment members, having a thicker cross-section are positioned at each end of the elongated member to prevent the bookmark from being withdrawn from either end of the book.

Contrary to the position taken by the Examiner, *Bailey, et al.*, does not teach or suggest the claimed invention. *Bailey, et al.*, is directed to a book-indicator. Specifically it is directed to an indicator or marks for books in which an indicating-strip lies transversely upon and is movable

vertically over the page of the book to indicate the lines thereof. (*Bailey, et al.*, Col. 1, lines 9-13)  
In *Bailey, et al.*, the book-indicator is strip A which lies across the page whereby "the stripe A being moved up and down over the surface of the page of the book will accurately indicate any line thereon desired." (*Bailey, et al.*, Col. 3, lines 22-25.)

Further *Bailey, et al.*, does not disclose or teach the utilization of a flexible, elongated member as a bookmark. Element C of *Bailey, et al.*, although described as being elastic, is provided with a stiffening sleeve E the purpose of which is to stiffen or provide inflexibility to member C at the point of attachment for strip A. Thus, *Bailey, et al.* teaches away from the claimed invention.

Thus, Applicants respectfully disagree with the Examiner's characterization of the disclosure or teaching of *Bailey, et al.* Furthermore, Applicants respectfully disagree with the Examiner's characterization of *Crane*. Contrary to the Examiner's characterization, Applicants submit that *Crane* does not teach the use of first and second abutment members. *Crane* is a design patent with only a plan view. This view does not disclose the head or legs portions of the bookmarks as being abutment members as claimed.

Furthermore, Applicants submit it would not have been obvious to modify *Bailey, et al.* by adding the top and bottom members of *Crane*. First, in *Bailey, et al.* the member C is held in place by hooks c which attach to the spine of the book. Thus, there is no reason or incentive to add abutment members since hooks c already serve to hold element C and the book indicator strip A in place. Mere ornamentation, as suggested by the Examiner is not a reason or motivation to add the elements of *Crane*. More importantly, the combination of *Bailey, et al.* and *Crane* would not result in the claimed invention.

Similarly, Applicants disagree with the Examiner's rejection of Claims 23 and 28. Applicants submit that there is nothing in *Bailey et al.* to suggest that it could be coiled about any abutment added to its lower end. The structure of *Bailey, et al.*, even if modified as suggested by the Examiner, is incapable of being coiled about its lower limbs. Stiffening sleeve E and strip A clearly teach away from attempting to coil member c around any abutment located at either end.

Finally, Applicants disagree with the Examiner's rejection of Claim 25. There is no suggestion or teaching in *Bailey, et al.* for joining hooks c together when the book-indicator is removed from actual use in a book.

#### The Claim 17 Rejection Under Section 103(a)

Applicants respectfully traverse the Examiner's rejection of Claim 17 as being unpatentable over *Bailey, et al.*, in view of *Crane* as applied to Claims 16, 18-25 and 28, and further in view of *Ward, et al.* As discussed above, Applicants respectfully traverse the Examiners position regarding the teachings or disclosure of both *Bailey, et al.* and *Crane*, as well as the suggestion or motivation to modify *Bailey, et al.* as suggested by the Examiner. For these same reasons, Applicants respectfully submit that it would not be obvious to utilize the three-dimensional feature of *Ward, et al.* in combination with *Bailey, et al.* and *Crane*. Although *Ward, et al.*, does teach that band A is elastic it does not teach the use of an elastic band as claimed. As shown in *Ward, et al.* band A extends beyond both ends of the book. Band A is held in place by clasps B which slide along band A to different positions to accommodate books of different sizes. The elasticity of band A is to allow for the removal of the hooks b<sup>2</sup> portion of the band by pulling on band A until hooks b<sup>2</sup> releases. Band A in *Ward* is not utilized to accommodate to books of differing sizes by virtue of its elasticity. *Ward, et al.* differs in construction and operation than the claimed invention and

Applicants respectfully submit that *Ward, et al.*, combined with *Bailey, et al.* and *Crane* does not render Claim 17 obvious.

The Claims 29-31 Rejection Under Section 103a

The Examiner has rejected Claims 29-31 as being unpatentable over *Bailey, et al.*, in view of *Crane* as applied to Claims 16, 18-28 and 28, and further in view of *Cox*. As discussed above, Applicants respectfully traverse the Examiners position regarding the teachings or disclosure of both *Bailey, et al.* and *Crane*, as well as the suggestion or motivation to modify *Bailey, et al.* as suggested by the Examiner. For these same reasons, Applicants respectfully submit that it would not be obvious to utilize the three-dimensional feature of *Cox* in combination with *Bailey, et al.* and *Crane*. The three-dimensional element of *Cox* is not an abutment member as claimed and there is not teaching or suggestion in either *Bailey, et al.* or *Cox* to combine the two. Moreover, Applicants submit that the combination of *Bailey, et al.*, *Crane* and *Cox* as suggested by the Examiner would not result in the claimed invention.

Thus, the Applicants respectfully submit that pending Claims 16-31, as amended, are allowable over the art of record. Applicants also submit that new Claim 32 is similarly allowable.

Proposed Drawings

Applicant hereby submits a new proposed drawing containing Figures 25 and 26 to show the features claimed in Claims 21 and 22. The new proposed drawing and the amendments to the specification pertaining to the drawings does not constitute new matter. Both the drawings and specification amendment are supported by the claims as originally filed.


CONCLUSION

Applicants respectfully submit that the claims, as amended, are allowable over the art of record and are in compliance with Section 112, 2<sup>nd</sup> paragraph. Therefore, Applicants earnestly request a Notice of Allowance. In the event there are any remaining informalities which need to be addressed to place the application in condition for a Notice of Allowance Applicants request a telephone call to the undersigned Attorney.

If any additional fees are due with this paper, please charge our deposit account 21-0800.

Respectfully submitted,

FULWIDER PATTON LEE & UTECHT, LLP

  
Gary M. Anderson  
Registration No. 30,729

GMA:srp  
Enclosure  
FULWIDER PATTON LEE & UTECHT, LLP  
200 Oceangate, Suite 1550  
Long Beach, California 90802  
(562) 432-0453